

ESTTA Tracking number: **ESTTA693276**

Filing date: **09/02/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

|                                       |   |
|---------------------------------------|---|
| Name                                  | Microsoft Corporation   |
| Granted to Date of previous extension | 09/02/2015  |
| Address                               | One Microsoft Way<br>Redmond, WA 98052-6399<br>UNITED STATES  |
| Attorney information                  | Grace Han Stanton, Holly M. Simpkins<br>Perkins Coie LLP<br>1201 3rd Ave Ste 4900<br>Seattle, WA 98101<br>UNITED STATES<br>pctrademarks@perkinscoie.com, gstanton@perkinscoie.com, hsimpkins@perkinscoie.com, jstarr@perkinscoie.com Phone:206-359-8000 |

### Applicant Information

|                                |  |                                 |            |
|--------------------------------|--|---------------------------------|------------|
| Application No                 | 86298922   | Publication date                | 05/05/2015 |
| Opposition Filing Date         | 09/02/2015   | Opposition Period Ends          | 09/02/2015 |
| International Registration No. | NONE   | International Registration Date | NONE       |
| Applicant                      | LG Electronics Inc.<br>128, Yeoui-daero, Yeongdeungpo-gu<br>Seoul 150-721,<br>KOREA, REPUBLIC OF |                                 |            |

### Goods/Services Affected by Opposition


Class 009. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Mobile phones

### Grounds for Opposition

|                                      |                            |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

### Marks Cited by Opposer as Basis for Opposition

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 4407849    | Application Date      | 03/09/2012 |
| Registration Date     | 09/24/2013 | Foreign Priority Date | NONE       |
| Word Mark             | WINDOWS    |                       |            |

|                     |   |
|---------------------|---|
| Design Mark         |   |
| Description of Mark | NONE  |
| Goods/Services      | Class 009. First use: First Use: 2005/05/00 First Use In Commerce: 2005/05/00<br>Wireless communications devices, namely, mobile phones, cellular telephones, personal digital assistants, and hand-held computers; computer software for wireless telecommunications for use with wireless devices; computer operating system software for wireless communication devices<br>Class 038. First use: First Use: 2005/05/00 First Use In Commerce: 2005/05/00<br>Telecommunications services, namely, offering personal communications services via wireless networks |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 4389703   | Application Date      | 09/29/2011 |
| Registration Date     | 08/20/2013  | Foreign Priority Date | NONE       |
| Word Mark             | WINDOWS PHONE   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 009. First use: First Use: 2010/11/00 First Use In Commerce: 2010/11/00<br>Wireless communications devices, namely, mobile phones, cellular telephones, personal digital assistants, and hand-held computers; computer software for wireless telecommunications for use with wireless devices |                       |            |

|             |   |
|-------------|---|
| Attachments | 85565790#TMSN.png( bytes )<br>85979589#TMSN.png( bytes )<br>2015-09-02 Microsoft Opposition.pdf(22095 bytes ) |
|-------------|---|

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

|           |                      |
|-----------|----------------------|
| Signature | s/Holly M. Simpkins/ |
| Name      | Holly M. Simpkins    |
| Date      | 09/02/2015           |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Microsoft Corporation,

Opposer,

v.

LG Electronics Inc.,

Applicant.

Opposition No.:

Mark: WinOZ

Serial No. 86298922

Filing Date: June 3, 2014

Published: May 5, 2015

**NOTICE OF OPPOSITION**

Opposer Microsoft Corporation (“Opposer” or “Microsoft”), which has its principal place of business at One Microsoft Way, Redmond, Washington 98052, believes that it would be damaged by registration of the mark WINOZ as shown in United States Trademark Application Serial No. 86298922 filed by LG Electronics Inc. (“Applicant”) and published for opposition on May 5, 2015. Opposer requested and received an extension of time to oppose to September 2, 2015. The Opposer opposes the application.

The grounds for this Opposition are as follows:

1. Opposer is in the business, inter alia, of developing and marketing computer software and related goods and services including wireless communications devices.
2. Commencing as early as October 18, 1983, Opposer has used and continues to use the mark WINDOWS in connection with developing and marketing computer programs, computer peripherals and related goods and services.
3. Opposer uses its WINDOWS mark and formatives thereof on a family of computer programs, computer peripherals, handheld computers, wireless communication devices, system products and other products and services. Opposer uses a family of WINDOWS marks in connection with such goods and services.
4. Opposer owns the following U.S. Trademark Registrations, among others:

| <b><u>Mark</u></b> | <b><u>Registration No.</u></b> | <b><u>Int'l Class(es)</u></b> |
|--------------------|--------------------------------|-------------------------------|
| WINDOWS            | 4,407,849                      | 9, 38                         |
| WINDOWS PHONE      | 4,389,703                      | 9                             |

5. Opposer's WINDOWS and WINDOWS PHONE marks symbolize the extensive goodwill and consumer recognition that have been developed by Opposer through substantial sales of products and services under those marks and through substantial and extensive advertising, promoting and popularizing of its WINDOWS and WINDOWS PHONE marks in the United States.

6. As a result of Opposer's use and advertising, Opposer's WINDOWS mark is a famous mark in the United States and is recognized as identifying the high-quality software programs, computer peripherals, handheld computers, wireless communication devices and other goods and services of Opposer. The WINDOWS mark and the associated goodwill are valuable assets of Opposer.

7. Applicant seeks to register the mark WINOZ for mobile phones in International Class 9.

8. Applicant's goods are identical to the goods and services marketed and sold by Opposer under Opposer's WINDOWS and WINDOWS PHONE marks.

9. Applicant's proposed mark WINOZ for Applicant's goods is confusingly and deceptively similar to Opposer's WINDOWS and WINDOWS PHONE mark for Opposer's goods and services, such that the trade and purchasing public are likely to be confused by and deceived into believing that the goods and services sold and marketed in connection with Applicant's WINOZ mark originate with or are otherwise authorized by, sponsored by, licensed by or associated with Opposer.

10. In view of the similarity of the parties' respective marks and the identical nature of the goods and services, Applicant's use of its proposed mark is likely to cause confusion, or to cause mistake or to deceive.

11. Applicant's proposed WINOZ mark dilutes and is likely to dilute Opposer's famous WINDOWS mark.

12. Opposer's WINDOWS mark was a famous mark before Applicant adopted its WINOZ mark.

13. By reason of all of the foregoing, Opposer would be greatly damaged by the registration of Applicant's WINOZ mark for the goods described in Applicant's application.

WHEREFORE, Opposer prays that this Opposition be sustained, the application denied and the mark refused registration.

Correspondence Address

Please direct all communications to:

Grace Han Stanton  
gstanton@perkinscoie.com  
William C. Rava  
wrava@perkinscoie.com  
Holly M. Simpkins  
hsimpkins@perkinscoie.com  
Perkins Coie LLP  
1201 Third Avenue, Suite 4900  
Seattle, Washington 98101

DATED this 2nd day of September 2015.

Respectfully submitted,

By s/Holly M. Simpkins  
Grace Han Stanton  
William C. Rava  
Holly M. Simpkins  
**Perkins Coie LLP**  
1201 Third Avenue, Suite 4900  
Seattle, Washington 98101-3099  
(206) 359-8000

Attorneys for Microsoft Corporation

CERTIFICATE OF SERVICE

I hereby certify that this Notice of Opposition is being deposited with the United States Postal Service with sufficient postage as first class mail on September 2, 2015, in an envelope addressed to Robert J. Kenney, Birch Stewart Kolasch & Birch, LLP, P.O. Box 747, Falls Church, VA 22040-0747.

Signature June Starr

Print Name: June Starr